

REMARKS

In the Final Office Action (“FOA”), the Examiner rejected claims 1, 6, 7, and 12-17 under 35 U.S.C. § 102(e) as anticipated by Newman et al., U.S. Patent No. 6,262,889, (“*Newman*”); rejected claims 3-5, and 9-11 under 35 U.S.C. § 103(a) as unpatentable over *Newman* in view of Jenkins et al., U.S. Patent No. 5,719,744, (“*Jenkins*”); rejected claims 2 and 8 under 35 U.S.C. § 103(a) as unpatentable over *Newman* in view of *Jenkins* as applied to claim 1, and further in view of Wong et al., U.S. Patent No. 6,509,657, (“*Wong*”); and rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over *Jenkins* in view of Quintana et al., U.S. Patent No. 6,522,531, (“*Quintana*”) as applied to claim 1, further in view of *Newman*.

Before addressing the merits of these rejections, Applicants point out several ambiguities in the Office Action which render the Action unclear. In the statement of rejection under section 102(e), the Examiner indicated that claims 1, 6, 7, and 12-17 were anticipated by *Newman*. (FOA at p. 2.) In the discussion of the rejection, the Examiner, however, referred to *Jenkins* in addition to *Newman*. (FOA at p. 2.) Specifically, the Examiner discussed elements of claimed invention which *Jenkins* allegedly teaches. (FOA at p. 2.) Since the rejection only recited *Newman* in the statement of rejection, it is unclear why *Jenkins* is discussed. Moreover, for a proper anticipation rejection, every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. M.P.E.P. § 2131, ed. 8, rev. 2 (May 2004)

Further, the Examiner rejected claim 6 as unpatentable over *Jenkins* in view of *Quintana* as applied to claim 1 and further in view of *Newman*. The Examiner, however,

never rejected claim 1 over *Jenkins* and *Quintana*. (FOA at p. 6.) Thus, this rejection is also unclear.

In view of these ambiguities, Applicants request that the Examiner withdraw the outstanding Final Office Action and issue a new Office Action which clearly sets forth the grounds of rejection. For the purposes of this response, Applicants will address the rejection under section 102(e) with respect to Newman. Applicants have not addressed the rejection of claim 6 under section 103(a) because Applicants can not determine the basis of *Jenkins* in view of *Quintana* as applied to claim 1 and because claim 6 was addressed in the section 102(e) rejection.

I. Response to Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1, 6, 7, and 12-17 under section 102(e) as anticipated by *Newman*. In response, Applicants submit that *Newman* fails to anticipate claims 1, 6, 7, and 12-17.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236 (Fed. Cir. 1989)). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131, 2100-73.

Claim 1 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, "a computer housing ... an integral battery with casing said casing is at least partially constructed of a thermally non-conducting

material, said housing having outside surfaces that when in use at least a portion are closest to the body of the user, said thermally non-conducting casing ... providing a user contact area on said mobile body supported computer that will not result in a burn injury.” Claim 7 is directed to a mobile body supported computer comprising similar recitations.

Newman is directed to a body supported mobile computer. *Newman* discloses that the mobile computer includes a battery 3 with an insulating cover 6. Battery 3, however, is located internally in the mobile computer. *Newman*, Fig. 1. Thus, cover 6 of battery 3 does not provide a contact area on the mobile computer.

Therefore, *Newman* fails to teach at least “said thermally non-conducting casing ... providing a user contact area on said mobile body supported computer that will not result in a burn injury” as recited in claims 1 (claim 7 contains a similar recitation). Accordingly, *Newman* fails to anticipate claims 1 and 7. For at least this reason, the Examiner should withdraw the rejection of claims 1 and 7.

Claim 6 depends from claim 1 and, thus, incorporates the elements of claim 1. For at least the reasons mentioned above, the Examiner should withdraw the rejection of claim 6.

Claim 12 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface to be against a users body, and a second surface located opposite to the first surface; [and] a heat insulating grille positioned on the second surface.”

Claim 13 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface to be against a users body, and a second surface located opposite to the first surface ... an integral battery positioned on at least a portion of the first surface and contained within a casing, the casing being partially constructed of a thermally non-conducting material.”

Claim 14 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface near a user’s body, and a second surface located opposite to the first surface; [and] a heat insulating member positioned on at least one of the first surface or the second surface.”

Claim 15 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing, the computer housing including substantially all of components of a conventional computer, having a first surface near a user’s body, and a second surface located opposite to the first surface; [and] means for inhibiting heat conduction positioned on at least one of the first surface or the second surface.”

Claim 16 is directed to a mobile body supported computer comprising a combination of elements including, *inter alia*, “a computer housing; a heat insulating grille located on at least a portion of the computer housing; [and] an integral battery with casing, the casing being at least partially constructed of a thermally non-conducting

material ... wherein the computer housing includes substantially all of the components of a conventional computer and the thermally non-conducting casing or the heat insulating grille providing a user contact area on the computer that will not result in a burn injury.”

Claim 17 depends from either claim 1 or 16.

Newman fails to teach at least these claim elements. Accordingly, *Newman* fails to anticipate claims 12-17. For at least this reason, the Examiner should withdraw the rejection of claims 12-17.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 3-5 and 9-11 under 35 U.S.C. § 103(a) as unpatentable over *Newman* in view of *Jenkins*; rejected claims 2 and 8 under 35 U.S.C. § 103(a) as unpatentable over *Newman* in view of *Jenkins* as applied to claim 1, and further in view of *Wong*. In response, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success.

M.P.E.P. § 2143, 2100-129 to 133. In this case, a *prima facie* of obviousness has not

been established at least because the references fail to teach or suggest all the claim elements.

A. *Newman* in view of *Jenkins* (Claims 1, 3-5, 9-11)

Claim 3-5 depend from claim 1 and, thus, incorporates the elements of that claim. Claim 9-11 depend from claim 7 and, thus, incorporates the elements of that claim. As mentioned above, *Newman* fails to teach or suggest at least “an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material ... said thermally non-conducting casing ... providing a user contact area on the mobile body supported computer that will not result in a burn injury,” as incorporated in claims 3-5 and 9-11. (See current response, remarks, § I.)

Moreover, *Jenkins* fails to cure the deficiencies of *Newman*. Since *Jenkins* fails to cure the deficiencies of *Newman*, these references, whether taken alone or in combination, fail to teach or suggest all the elements of claims 3-5 and 9-11. Thus, a *prima facie* case of obviousness has not been established for claims 3-5 and 9-11. For at least this reason, the rejection of claims 3-5 and 9-11 under section 103(a) is improper and should be withdrawn.

B. *Newman* in view of *Jenkins* and further in view of *Wong* (Claims 2 and 8)

Claim 2 depends from claim 1 and, thus, incorporates the elements of that claim. Claim 8 depends from claim 7 and, thus, incorporates the elements of that claim. As mentioned above, *Newman* fails to teach or suggest at least “an integral battery with casing said casing is at least partially constructed of a thermally non-conducting material ... said thermally non-conducting casing ... providing a user contact area on the mobile

body supported computer that will not result in a burn injury,” as incorporated in claims 2 and 8. (*See* current response, remarks, § I.)

Moreover, *Jenkins* and *Wong* fail to cure the deficiencies of *Newman*. Since *Wong* fails to cure the deficiencies of *Jenkins* and *Quintana*, *Jenkins*, *Quintana*, and *Wong*, whether taken alone or in combination, fail to teach or suggest all the elements of claims 2 and 8. Thus, a *prima facie* case of obviousness has not been established for claims 2 and 8. For at least this reason, the rejection of claims 2 and 8 under section 103(a) is improper and should be withdrawn.

III. Conclusion

For at least the reasons mentioned above, Applicants submit that the rejections of the pending claims are improper and should be withdrawn. Applicants submit that the present claims are in condition for allowance and request reconsideration and allowance of the pending claims.

Respectfully submitted,

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